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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,018	01/16/2001	Rich Gioscia	PALM-3555	8040

7590 03/17/2004
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Two North Market Street
San Jose, CA 95113

EXAMINER

NGUYEN, SIMON

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 03/17/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,018

Applicant(s)

GIOSCIA ET AL.

Examiner

SIMON D NGUYEN

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 11-14, 16-19, 25-28, 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Katsura (6,628,962).

Regarding claim 1, Katsura discloses an electronic device (abstract, figs.4-5), comprising: a first element (#1a figs.4-5) comprising a first side bearing an interface operable to be used as a wireless phone (column 7 lines 4-14, figs.4-5, 11), a second side (#14 of fig. 5) comprising a first part of a display (#2) of a portable computing device; and a second element (1b) comprising a third side and a fourth side wherein the third side comprising a second part of the display (#2) of the PDA; wherein the first element is movably attached with the second element, and configurable in a first configuration for use as a wireless phone and configurable in a second configuration for use as the PDA (column 7 lines 4-63, figs.4-5).

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Regarding claims 16 and 30, these claim are rejected for the same reason as set forth in claim 1, wherein the Katsura's electronic device inherently includes a processor and a memory.

Regarding claims 2-3, 17-18, Katsura further discloses the first configuration is a closed configuration (fig.4) and the second configuration is in an opened position (fig.5).

Regarding claims 4 and 19, Katsura further discloses the PDA (column 4 lines 30-34).

Regarding claims 11 and 25, Katsura further discloses a dual-sided display (fig. 5).

Regarding claims 12 and 26, Katsura discloses a PDA having a display implementing pen input (column 4 line 38, column 5 line 3).

Regarding claims 13-14 and 27-28, Katsura discloses an electronic device having two modes, a phone mode and a computing mode (column 4 lines 63-67), at a phone mode a portion of display is visible through a display window (fig. 4, column 5 line 24).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 5-10, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsura (6,628,962) in view of Cannon et al. (6,393,272).

Regarding claims 5-10 and 20-24, Katsura fails to disclose the electronic device places wireless communication on hold/ off hold and these features are displayed.

Cannon discloses a communication device including a display for displaying a call holding/off holding (column 3 lines 20-67, fig.2). It should be noted that when the user of the electronic device use a headphone or earphone, the wireless communications are inherently placed off hold in order the user can listen/answer the call. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have Katsura, modified by Cannon in order to maintain a connection status of the incoming call as the electronic device incorporated with the PDA.

5. Claims 15 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsura (6,628,962) in view of Imai (6,389,267).

Regarding claims 15 and 29, Katsura fails to disclose a phone related information is displayed atop the surface of a second side and a third side.

Imai discloses a mobile phone having a display for displaying phone related information atop the surface of a first side and a second side in a flexible dual-sided display (fig.7A). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have Katsura, modified by Imai to improve the operation of a folded multi-functioned communication device.

Response to Arguments

6. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nielson et al. (6,331,840) and Wang et al. (5,734,513) discloses a foldable electronic device having dual-sided displays (see figs.10-11 of Wang et al. and fig.2 of Nielson et al.).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Nguyen whose telephone number is (703) 308-1116. The examiner can normally be reached on Monday-Friday from 7:00 AM to 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban, can be reached on (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

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Washington, D.C. 20231

Or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Hand-delivered response should be brought to Crystal Park II,

2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Simon Nguyen

March 8, 2004

A handwritten signature in black ink that reads "Simon Nguyen". The signature is written in a cursive, flowing style.